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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,465

08/14/2003

Marc Mathews

2164

7590

07/07/2006

Marc Mathews
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LINCOLN, NE 68516

EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/642,465

Applicant(s)

MATHEWS, MARC

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,869,359. Although the conflicting claims are not identical, they are not patentably distinct from each other because the primary difference between the two sets of claims in the indicia used. The indicia used in a game are a matter of aesthetic design choice.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fey (*Slot Machines, A Pictorial History of the First 100 Years*) in view of Stern (US 2002/0074725).

Claims 1, 2, 4: Fey teaches the Mills 1929 Baseball Vender (page 167). The Baseball Vender is a gaming apparatus with a sports theme – i.e., baseball. There is a plurality of independently and randomly selected symbols disposed in a rectangular positional array. Each of the symbols of said plurality is directly related to a single predetermined sport. (See the reel strip along the side of the page.) The outcome of a gaming sequence using said display is a function of the symbols displayed along the payline. The player places a bet on the payline prior to the beginning of the game. Fey does not teach that the rectangular array comprises four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array. Stern teaches a rectangular array comprising four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array. Providing larger arrays of symbols with multiple paylines is extremely well known to the art. This allows players to bet on more propositions, thus increasing the handle (i.e., the profits) on the gaming machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Baseball Vender in view of Stern to include a rectangular array comprising four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array in order to provide

more proposition upon which a player may bet, thus increasing profits. The existence of the game clearly implies the structure necessary to carry out the game.

Claim 5: Fey teaches enabling the gaming apparatus to play a bonus round of a gaming sequence in the event that a patron selects a predetermined payline, bets a predetermined amount of money on the payline, and receives a predetermined arrangement of predetermined symbols along the predetermined payline. A winning combination results in playing the bonus baseball game depicted on the front of the cabinet.

Regarding the newly added limitations: The selection of the visual appearance of a symbol is purely a matter of aesthetic design choice. Determining the probability of a symbol's (or combination of symbols) appearance on the reels and the payout associated with that probability is the very basis of the art. Every practitioner of the art must know how to properly design a payable in order to stay in business. Applicant's newly added limitations merely say that certain symbols or combinations will appear on the reels of a slot machine and the payout will be determined by the probability that these symbols will appear on the payline during play of the game. This is true of every slot machine.

5. Claims 3 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fey in view of Stern as applied to claims 2 or 5 above, and further in view of Morro et al. (US Patent Number 6,162,121).

Claims 3 & 6: Fey and Stern teaches the invention substantially as claimed, but fails to teach a first, second and third display regions each of which include means for displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games. Morro teaches a slot machine with a first,

Art Unit: 3714

second and third display regions (i.e., 608A-C) each of which include means for displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games. Morro discloses that having three wheels allows the casino to offer larger jackpots that attract more players. (Col 2, 47-60) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fey and Stern in view of Morro to include a first, second and third display regions each of which include means for displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games in order to allow the casino to offer larger jackpots thus attracting more players.

6. Applicant's arguments filed 11 May 2006 have been fully considered but they are not persuasive.

7. With regard to the Double Patenting Rejection – the rejection will be maintained until a terminal disclaimer is filed.

8. With respect to the Drawing Objection – Applicant appears to have submitted the same drawings as last time. They are still objected to, however, Examiner will wait until the Draftsman has reviewed them to formally object again.

9. Applicant's arguments with respect to the claims are addressed in the rejection above.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

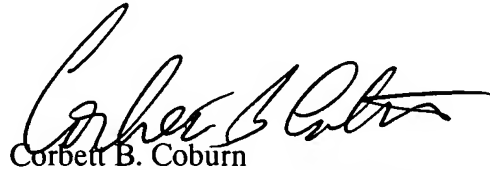
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 3714

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", is positioned above the printed name and title.

Corbett B. Coburn
Primary Examiner
Art Unit 3714

**CORBETT B. COBURN
PRIMARY EXAMINER**